

REMARKS

This amendment is responsive to the Office Action dated March 29, 2005. Claims 1 - 12 are pending in this application. Claims 1 - 4 and 7 - 10 are rejected. Claims 5, 6, 11, and 12 are objected to. Reexamination is respectfully requested in light of the following amendments.

These remarks follow the order of the outstanding Office Action beginning at page 2 thereof.

Specification

Applicant has made appropriate corrections of pages 14 and 15 to correct spelling in the specification.

Claim Objections

Applicant has made appropriate corrections in claims 3 - 6 and 9 - 12 in order to correct informalities as noted by the Examiner.

Double Patenting

Applicant has reviewed the rejection on the basis of Double Patenting as applied to claims 9 and 10. It was discovered that the dependency of these claims was inadvertently made identical

to claims 3 and 4. Appropriate change in the dependency of claims 9 and 10 has now been made in order to make them substantially different from claims 3 and 4.

Claim Rejections - 35 USC § 102

Claims 1 - 4 and 7 - 10 have been rejected as being anticipated by Aylott '123 and Ogunro '055.

It appears to Applicant that the Examiner has made this rejection based upon a theory that the preamble of the claim could be ignored. However, the preamble of each claim relates to a nail cover for a clip, not for a human nail. Both the '123 and '055 references are clearly attachments for human beings, not clips.

Applicant has amended claims 1, 2, 7 and 8 in order to more clearly define the invention and exclude a human nail. In the amendment, Applicant states that the ditch of the cover is inserted into the clip, thereby attaching the cover to the clip.

In the references, there is no clip and no relationship of the clip to the cover.

In accordance with accepted claim interpretation, the claims as now presented clearly incorporate the preamble into the body of the claim by direct reference back to the cover portion of the clip in the body of the claim. It is, therefore, respectfully submitted that the claims are now allowable over the prior art of

record because there is no clip in the prior art.

Interpretation of Preamble

Applicant requests the Examiner to refer to Kropa v. Robie 187F2d, 150, 152, 88 USPQ 478-481. The case does not imply that the preamble of the claim neither recites the limitations of the claim nor is the preamble necessary to give life, meaning and vitality to the claim. In fact, the Kropa decision held that the Kropa preamble limitation was meaningful in the claim, and that the party Kropa could not ignore this limitation in asserting priority over the other party to the interference. Kropa, therefore, holds that on its facts, the limitation in the preamble was recited in the claim. Kropa states as follows:

"In the case before us, the words "An abrasive article" are essential to point out the invention defined by the counts. In our judgment those introductory words give life and meaning to the counts, for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article." (See Kropa 88 USPQ page 481)

It is, therefore, respectfully submitted that Kropa does not support ignoring of preambles.

MPEP § 211.02 supports Applicant's contention that the preamble language of the claims is clearly a part of Applicant's invention which must be considered with the other elements of the claim. The preamble of Applicant's claim 1 has a clip which is

also in the body of the claim.

In Applicant's claim 1, Applicant sets forth a combination which is not disclosed in the prior art. There is no clip and nail in the art. Applicant's preamble recites a new device and, therefore, gives life and meaning. Stated simply, a preamble is essential to point out the invention defined by the claim which is a requirement where the preamble is being limited in accordance MPEP § 2111.02.

In Chisum Patents 8.01[1], the author after discussing the Kropa v Robie 187F.2D.150,88 USPQ 478 (CCPA 1951) (discussed infra) refers to Marston v. J.C. Penney Co., (1965), 353 F2d 976, 148 USPQ 25 (4th Cir. 1965) where the case turned upon whether the claim can be read independently from the preamble. Chisum concludes that whether the preamble must be read to give the meaning to the claim if it is essential to the point of invention. The preamble here describes a unique article to which the claim body alone is referable. Therefore, as concluded in Chisum 8.01[1] page 8-116 in the discussion of Marston v. J.C. Penney Co., Applicant's preamble is an essential limitation to the rest of the claim.

This clip and nail combination is a positive article recitation of a new device which breathes life and meaning into the claim as opposed to a limitation which merely states an intended use. See Loctite Corp. v. Ultrascaltd Ltd. 781 F. 2d

861 228 USPQ Fed. Cir. 1985.

In Corning Glass Works v. Sumitomo Electric U.S.A., Inc.,
868 F. 2d 1251, 9 USPQ 1962 Fed. Cir. (1989), the claim reads as
follows:

"An optical wave guide comprising:
(a) a cladding layer formed of a material. . ."

All of the limitations of the claim after the word
"comprising" were found broadly disclosed a single reference
United Kingdom Patent No. 1,113,101. In this case, all of the
limitations are not found in a single reference (103 rejections).

In fact, all of the limits are not found at all. The defense was
anticipation which requires every limitation in issue to be
disclosed. In Corning, the structure as claimed was considered
to be identical to the structure broadly disclosed in the '101
reference. In Corning the Court held that the preamble
constituted a limitation in the claim which allowed the claim to
define over the prior art which would otherwise broadly
anticipate the rest of the claim.

In Corning, an addition to the structure set forth in the
claim, there was argued that the prior art reference while
disclosing all elements of the claim, failed to properly function
as an optical wave guide because it could only transmit for a few
meters, rather than a long distance. The Court reasoned that the

effect preamble language should be given can be resolved only in view of the entirety of the specification to gain an understanding of what the inventors actually invented and intended to encompass by the claim. Here, Applicant contends that the claim at issue and what the inventors intended to encompass was a clip and nail. Applicant's specification in accordance with Corning should be read to determine what a clip and nail is or in the case of Corning what an optical waveguide was. In Corning, unclaimed structure dimensions and refractive index differentials described in the specification were required so that the claimed structure would function as an optical waveguide. Applicant like Corning discloses additional unclaimed structure.

Corning stated "To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification..., the claim preamble in this instance does not merely state a purpose or an intended use for the claim structure... rather these words get 'life and meaning' and provide further positive limitations to the invention claimed." (See 9 USPQ 2d, 1966).

In Corning, the core and cladding limitations were not the only limitations in the claim. The claim preamble required, in addition, the particular structure relationship defined in the specification for the core and cladding to function as an optical waveguide". See Chisum § 8.06 [1] page 8-119 and 9 USPQ 2d 1966.

Applicants respectively submit that Applicants' specification must be compared to the specification of the 35 USC § 102 rejection. Here, in the specifications are where the definition of Applicant's claimed invention and the device disclosed in the art relied upon differ.

The Kropa v. Robie 187 F. 2d 150. 88 USPQ 478 (CCPA 1951) decision is well known as the Court of Customs and Patent Appeals attempt to resolve the legal issue of when a preamble can be given the effect of a limitation in a claim. Here, the court reviewed 37 of its own prior decisions where 27 held that the preamble was not a limitation and 10 held that the preamble was a limitation. The Kropa Court was quoted by Chisum as follows:

"The preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness, upon the introductory clause; or where the claim or count was drawn to a product and the introductory clause merely recited a property inherent in the old composition defined by the remaining part of the claim. In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of

that subject matter. On the other hand, in those ex parte and interference cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over the prior art."

The most significant portion of the above quote is the underlined portion which relates to cases where there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The prior art relied upon by the Examiner however, is not a solution to the problem of decorating a clip, but rather is a solution to a nail for a human, a very different problem indeed. The Examiner has not shown how the two references even suggest Applicant's solution in a different art.

In Kropa v Robie, the claim was "an abrasive article comprising ...". Kropa argued that his application was entitled to the filing date of his prior 1938 application which disclosed the addition of grains and 2 resins but did not disclose an abrasive article as such. The 1938 case disclosed the elements of the claim body, but not the elements of the body limited by the preamble phrase "abrasive article". Kropa argued that the subject matter of the claim "count in an interference" was the

body of the claim without the limitation. Instead, the Court held the claim in question did include "abrasive article" as a limitation since the "term calls for a distinct relationship between a proportion of grain and resin" therefore concluded that Kropa was not entitled to the 1938 filing date of his prior application. Since Kropa could not copy the Robie claim with an abrasive article preamble, Kropa was not able to provoke the interference.

In this instance, the Court held that the abrasive article limitation was a necessary part of the copied claim which was not disclosed in the prior 1938 application.

The Kropa decision supports the concept that the preamble must be included in the claim if it is essential to particularly point out the invention defined by the claims.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current

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condition, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "L.J. Marhoefer". The signature is stylized with a large initial "L" and a cursive "J".

L.J. Marhoefer
Reg. No. 21,091 signing for
Ronald R. Snider
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Date: May 23, 2005

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